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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 807,664	07 05 2001	Wolfgang Becker	H3624PCT US	2217

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COGNIS CORPORATION
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EXAMINER

HOWARD, JACQUELINE V

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 09 06 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,664

Applicant(s)

BECKER ET AL.

Examiner

Jacqueline V. Howard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 10 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 11-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 11-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

A careful study of U.S. Patent 5,439,709 to Becker revealed that process claims 11 to 24 would be obvious in view of the teaching therein. Accordingly the indicated allowability of claims 11 to 24 is withdrawn.

An action on these claims follows.

Claims 11 to 28 are pending.

Claims 11 to 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker et al (5,439,709).

The reference teaches a process of lubricating textile fibers comprising contacting said fibers with a smoothing agent consisting of fatty acid methyl esters which have been produced by transesterification of natural triglycerides, including coconut oil, palm oil, rapeseed oil, soybean oil (col. 1, lines 54 to 61). Suitable textile fibers are textile fibers of natural and/or synthetic origin. Wool is specifically taught as one such fiber to be lubricated with the fatty acid methyl ester (col. 4, line 60).

The composition is used in the form of an emulsion. Emulsifiers to be used in the composition are taught at col.2, line 12 to 25.

Applicant claims a lubricant composition for wool fibers and a process for using said lubricant composition. It is the examiner's position that the claimed invention would be prima facie obvious.

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Applicants arguments in response to the Office Action dated January 11, 2002 are rendered moot in view of the new application of the reference to the claims. Intended use is not an issue since patentee does include wool fibers in his list of suitable textile fibers. The fact the Patentee chose to exemplify his lubricating process and product using tallow does not negate the fact that he taught using fatty acid methyl ester of the same fatty acids claimed in the instant invention. Patents are not used just for what is in the illustrative examples but what they realistically teach in the specification and claims. The claims of the reference are likewise not limited to tallow, but are to saturated or unsaturated C_8 - C_{22} fatty acid methyl esters.

One desirous of providing a smoothing agent for textile fibers, including wool fibers, during the lubricating process which would result in higher yield product having enhanced properties would be motivated to use a C_8 - C_{22} fatty acid methyl ester of the type set forth in the instant claims, because the prior art teaches treating the same textile fibers with the same smoothing agent. It is not unobvious to follow the teaching of the prior art.

Any inquiry concerning this communication should be directed to J. Howard at telephone number 703-308-2514.

Howard/sp

August 29, 2002


J. HOWARD
SENIOR EXAMINER
GROUP 1700